

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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7
8 *Ex parte* CRAIG L. BROOKS and MARK A. MOSLEY
9

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11 Appeal 2007-2498
12 Application 09/758,865
13 Technology Center 3600
14

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16 Decided: November 30, 2007
17
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19
20 *Before:* TERRY J. OWENS, JENNIFER D. BAHR, and
21 STEVEN D.A. McCARTHY, *Administrative Patent Judges.*
22
23 McCARTHY, *Administrative Patent Judge.*
24

25 DECISION ON APPEAL

26
27 STATEMENT OF THE CASE

28 The Appellants appeals under 35 U.S.C. § 134 (2002) from the final
29 rejection of claims 1-10. We have jurisdiction under 35 U.S.C. § 6(b)
30 (2002).

4

1 The Appellants' invention relates to a display device adapted to hang
2from the exhaust pipe of an automobile or truck. As described in the
3Appellants' Specification:

4

5 [A] display apparatus according to one
6 embodiment [has] a display portion [] for attaching
7 a display article, sticker, label, nameplate, etc. The
8 display portion [] is placed on a vehicle so as to be
9 visible from behind the vehicle, wherein the
10 display portion [] is coupled to an exhaust pipe of
11 the vehicle. The display portion [] has a receiver
12 portion [] illustrated as a ball and socket assembly.
13 The receiver portion [] of one embodiment is made
14 up of the ball portion [], wherein the ball portion []
15 [is] coupled to a socket for connection to [a]
16 connector []. Connector [] couples the receiver
17 portion [] within the socket [] to a tailpipe
18 attachment piece []. The tailpipe attachment piece
19 [then] couples to the exhaust pipe or the tailpipe of
20 a vehicle.
21

22(Specification ¶ 1060 [reference numerals omitted]).

23 Independent claim 1 is representative of the claims on appeal and
24reads as follows:

25

- 26 1. A display apparatus, comprising:
27 a tailpipe attachment piece, adapted for
28 coupling to an exhaust pipe of a
29 vehicle; and
30 a receiver piece coupled to the tailpipe
31 attachment piece, wherein the receiver
32 piece is adapted for coupling to a
33 display piece such that the display
34 piece hangs below the exhaust pipe
35 and approximately perpendicular to

8

1 the length of the exhaust pipe
2 providing exposure to the display
3 piece from behind the vehicle.
4

5 Claims 1, 2 and 4-9 are rejected under 35 U.S.C. § 102(b) as being
6anticipated by Squires (U.S. Patent 1,730,790). Claims 1-3, 6, and 8 are
7rejected under 35 U.S.C. § 102(b) as being anticipated by Connolly (U.S.
8Patent 1,440,061). Claims 1, 2, 6 and 8-10 are rejected under 35 U.S.C.
9§ 102(b) as being anticipated by Binner (U.S. Patent 4,349,246).

10 We affirm.

11

12 ISSUE

13 The sole issue in this appeal is whether Squires, Connolly and Binner
14disclose apparatuses including “tailpipe attachment pieces” as recited in
15claim 1.

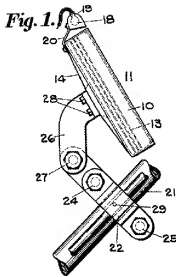
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17 FINDINGS OF FACT

18 The record supports the following findings of fact by a preponderance
19of the evidence.

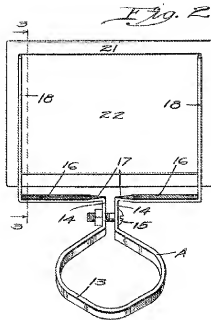
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21 1. Squires discloses a map holder designed to clamp onto an
22exposed steering column of an automobile. (Squires 1, ll. 1-8 and 86-95).
23Figure 1 of Squires, reproduced below, is a side elevational view showing
24Squires’ map holder coupled to the exposed steering column of an
25automobile.



1
2 2. Squires' map holder includes a rectangular metal casing (10 in
3Fig. 1) having a front aperture covered by a transparent plate. (Squires 1, ll.
445-52 and 2, ll. 39-42). An adjusting bar (26 in Fig. 1), is bolted at one end
5to the back of the casing. (Squires 1, l. 96 – 2, l. 4). A pair of clamping
6bands (only one clamping band, 22, shown in Fig. 1) embraces the car's
7steering post (21 in Fig. 1). (Squires 1, ll. 86-95). The free end of the
8adjusting bar is bolted to a free end of one of the clamping bands, permitting
9the driver to pivot the adjusting bar and casing relative to the steering post so
10as to display the map to the driver. (Squires 2, ll. 19-24).

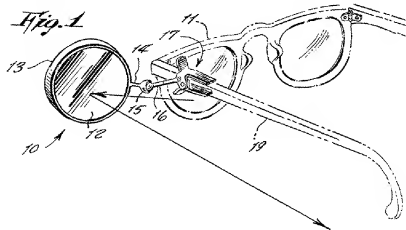
11 3. Connolly discloses a license card holder for a car. Figure 2 of
12Connolly, reproduced below, is a front elevational view of the license card
13holder.



1
2 4. The license card holder includes a single metal strip (A in Fig.
32) bent midway between its ends to form a loop (13 in Fig. 2). (Connolly 1,
4ll. 36-39). The two ends of the metal strip are bent symmetrically into a
5 fork-like shape with parallel portions (14 in Fig. 2) extending from the loop;
6 co-linear projections (16 in Fig. 2) extending perpendicularly in opposite
7 directions from the ends of the parallel portions; and parallel arms (18 in
8 Fig. 2) extending perpendicularly from the ends of the projections in the
9 same direction as that in which the parallel portions extend from the loop. A
10 bolt (15 in Fig. 2) extends through registered openings in the parallel
11 portions to tighten the loop around the car's steering post. (Connolly 1, ll.
12 47-62).
13 5. The license card is held in a metal container (21 in Fig. 2)
14 having a semi-transparent covering (22 in Fig. 2). (Connolly 1, ll. 67-70).
15 Notches formed in free ends of the arms position the metal container for
16 displaying the license card within the vehicle. (Connolly 1, ll. 71-73). The

1projections may be twisted slightly to position the license substantially
2vertically when the holder is coupled to the steering post. (Connolly 1, ll.
352-57).

4 6. Binner discloses a rear view mirror designed to be clipped to a
5person's eyeglasses or hat. Figure 1 of Binner, reproduced below, is a
6perspective view of the rear view mirror clipped to an eyeglass frame.



7
8 7. Binner's device:

9
10 includes a mirror 12 fitted in a frame 13. A
11 sideward stem 14 [is] rigidly affixed to a side edge
12 of the frame. An outer end of the stem is
13 connected by mean of a universal ball-and-socket
14 joint 15 to an end of a stem 16 affixed to a side of
15 clamp 17 having spring-loaded tongues [] for
16 being clamped around upper and lower sides of an
17 eye glasses temple bar 19. Each tongue is slitted
18 on its end with slits [] so as to form fingers [] that
19 grasp more efficiently around cylindrical surfaces
20 such as when a temple bar is rounded.
21

22(Binner, col. 1, l. 57 – col. 2, l. 13 [reference numerals not appearing in Fig.
231 omitted]).

1 PRINCIPLES OF LAW

2 “To anticipate a claim, a prior art reference must disclose every
3limitation of the claimed invention, either explicitly or inherently.” *In re*
4*Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). “Under the principles of
5inherency, if the prior art necessarily functions in accordance with, or
6includes, the claimed limitations, it anticipates.” *In re Cruciferous Sprout*
7*Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002).

8 An applicant may define parts of a claimed apparatus by reciting
9physical characteristics or relationships of the parts (that is, by means of
10“structural limitations”) or by reciting functions which the parts perform or
11are adapted to perform in the apparatus (that is, by means of “functional
12limitations”). An Examiner may reject a device claim on the basis of an
13unrebutted “prima facie” case. If a claim includes functional limitations, the
14Examiner may establish a prima facie case for anticipation by showing
15merely that a prior art reference discloses all of the structural limitations of
16the claim. Once the Examiner establishes a prima facie case, the Examiner
17may shift the burden of proof to the applicant to show that the apparatus
18disclosed in the reference does not meet the functional limitations of the
19claim inherently. *Schreiber*, 128 F.3d at 1478.

20

21 ANALYSIS

22 Claim 1 stands rejected as anticipated by Squires, Connolly and
23Binner. Each of the remaining claims 2-10 stands rejected as anticipated by
24at least one of those references. The “Argument” section of the Appellants’
25Brief addresses only the language of claim 1. Therefore, the Board will
26decide the patentability of claims 1-10 as a group, claim 1 being deemed

1representative of the group. Since the Appellants did not argue claims 2-10
2separately, the Appellants have waived any argument that the patentability
3of claims 2-10 should be considered separately from the patentability of
4claim 1. 37 C.F.R. § 41.37(c)(vii); *In re Young*, 927 F.2d 588, 590 (Fed.
5Cir. 1991).

6 The Examiner rejected representative claim 1 as anticipated by
7Squires, Connolly and Binner. The first step in determining whether
8Squires, Connolly and Binner disclose apparatuses having “tailpipe
9attachment pieces” is to determine the scope of the claim language. When
10addressing issues of anticipation,

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12 the [Patent and Trademark Office] applies to the
13 verbiage of the proposed claims the broadest
14 reasonable meaning of the words in their ordinary
15 usage as they would be understood by one of
16 ordinary skill in the art, taking into account
17 whatever enlightenment by way of definitions or
18 otherwise that may be afforded by the written
19 description contained in the applicant’s
20 specification.
21

22*In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

23 According to its ordinary usage, a “piece” is simply any part of the
24apparatus. See *WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY* at 1712
25(G. & C. Merriam Co. 1971) (definition 1). The first piece recited in the
26body of claim 1 is a “tailpipe attachment” piece in the sense that the piece is
27“adapted for coupling [to] an exhaust pipe of a vehicle.” The common
28meaning of the word “adapted” is “suited by nature, character, or design to a
29particular use, purpose, or situation.” *Id.* at 24. Hence, the phrase “adapted

1for . . .” does not imply the actual performance of the particular use or
2achievement of the particular purpose for which the object is suited. Given
3its broadest reasonable interpretation, the “tailpipe attachment piece”
4limitation of claim 1 is met by any part suited by nature, character or design
5for coupling to an exhaust pipe of a vehicle, regardless whether the prior art
6teaches the actual coupling of that part to an exhaust pipe.

7 The second step in determining whether Squires, Connolly and Binner
8disclose the subject matter of claim 1 is to determine whether Squires,
9Connolly and Binner disclose apparatuses having “tailpipe attachment
10pieces” as recited in that claim. As illustrated in the drawings of the
11Appellant’s application, a conventional tailpipe is a straight or bent
12cylindrical tube. Squires’ clamping bands, Connolly’s looped metal strip
13and Binner’s clamp are each adapted for attachment to a cylindrical object.
14(FF 2, 4 and 7). Therefore, each is, prima facie, a “tailpipe attachment
15piece.” When combined with Squires’ adjustment bar, Connolly’s arms and
16Binner’s sideward stem, respectively, the combinations prima facie
17anticipate claim 1.

18 This prima facie case shifts the burden of proof to the Appellants to
19show that Squires’ clamping bands, Connolly’s looped metal strip and
20Binner’s clamp are not adapted inherently for attachment to a tailpipe. The
21Appellants have not rebutted the Examiner’s prima facie case. On the record
22before us, the Examiner’s rejection of claim 1 is proper.

23 In an effort to rebut the Examiner’s prima facie case, the Appellants
24argue that “Appellants’ claims recite structure and functions not taught or
25suggested by the prior art references. The prior art references all provide
26visibility to a driver or user. There is no teaching or suggestion of a tailpipe

1display device providing visibility from behind an exhaust pipe. There is no
2teaching of a tailpipe attachment piece.” (Br. 6).

3 “It is well settled that the recitation of a new intended use for an old
4product does not make a claim to that old product patentable.” *Schreiber*,
5128 F.3d at 1477. For this reason, the failure of Squires, Connolly and
6Binner to “teach” the particular use to which the Appellants intend to put
7their device, that is, the failure of the references to disclose the coupling of
8their respective apparatuses to the tailpipes of land vehicles, does not rebut
9the Examiner’s contention that Squires’ clamping bands, Connolly’s looped
10metal strip and Binner’s clamp are adapted for coupling to cylindrical
11objects such as tailpipes. If coupled to a tailpipe of a vehicle and properly
12oriented, each of the prior art apparatuses would provide exposure of a part
13corresponding to a “display piece” (namely, Squires’ casing, Connolly’s
14metal container and Binner’s mirror) from behind the vehicle.

15 On the record before us, the Examiner properly rejected claim 1 as
16anticipated by Squires, Connolly and Binner. Claims 2-10 were grouped
17with claim 1 for purposes of this appeal and fall with that claim.

18

19 CONCLUSION OF LAW

20 On the record before us, the Appellants have not shown that the
21Examiner erred in rejecting the appealed claims as anticipated by Squires,
22Connolly and Binner.

23

24 DECISION

25 The Examiner’s rejection of claims 1-10 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

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5 AFFIRMED

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